

**Remarks**

Reconsideration of the application is respectfully requested. Claims 1-20 are pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

**Claim Rejection - 35 U.S.C. §102:**

Claims 1, 4, 8, 9, 11, 13-15 and 18-20 were rejected under 35 U.S.C. §102 as being anticipated by Michael (U.S. 2004/0170263).

MPEP §2129 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631,2 USPQ2d 1051,1053 (Fed. Cir.1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226,1236,9 USPQ2d 1913,1920 (Fed. Cir.1989).

**Claim 8 (and 9):**

Claim 8 depends on claim 1 which addresses a method for providing presence state information. First messages are received from a switch in the PSTN containing call event information for leased one telephone line served by the switch. A presence state is determined for a PSTN subscriber associated with the at least one telephone line based on the call event information where the call event information defines both when the one telephone line is available and is not available to receive a call. A second message is transmitted using Internet protocol to a first Internet terminal equipment where the second message contains the presence state information

associated with the at least one telephone line. It should be noted that the present state is based on call event information that defines both when the subject telephone line is available and is not available to receive a call.

In claim 8 itself, first messages are received from the at least one switch are in a PSTN compatible protocol and are transmitted on every occurrence of the one telephone line changing from one presence state to another presence state.

In the Office Action it is alleged that Michael discloses sending the first message from the PSTN switch in a PSTN compatible protocol citing Michael, FIG. 4, element 408. The requirement of transmitting every occurrence of one telephone line of the PSTN changing from one presence state to another present state is alleged to be taught at FIG. 2, elements 206, 208. The flow diagram of Michael's FIG. 2 states for step 206: "user logs into or uses monitored system"; for step 208: "DPP [dynamic presence proxy] distributes presence updates to watchers".

Paragraph 21 of Michael describes the flow chart of FIG. 2. It is explained regarding step 206 that a user who is not logged in the present system nevertheless makes use of a monitored system. An example is provided for a user, Juliet, (see 1120d of FIG. 1) being coupled to the telecommunication server 1102, then makes a telephone call through the routing system 1116. This routing system handles the calling party (Juliet) and provides the information to the dynamic presence proxy 1114, which updates the login parties' presence at step 208. It is stated that the dynamic presence proxy communicates with the presence server 1104 with the identity of the calling party (Juliet). Thus, the system determines that the calling party, Juliet, is a registered user but not logged in to the presence system. The presence server then sends out a presence update to the logged in watching parties that are monitoring for the presence of Juliet.

It will be clear to one of ordinary skill the art, upon reviewing Michael's FIG. 2 and the associated descriptive text, that Michael does not teach **first messages originated by a PSTN switch** are transmitted on every occurrence of the one phone line coupled to the PSTN changing from one presence state to another presence state. The only way that Michael determines a

change of presence of a targeted user is for the targeted user to originate a call processed by the routing system 1116 or to receive an inbound call processed by the routing system 1116.

Assume a user, Bob, is supported by telephone line directly connected to PSTN 118 (FIG. 5 of Michael). Further assume that Bob is on the watch list maintained by presence server 1104 so that the presence state of Bob's telephone is desired to be maintained. If Bob originates a call through PSTN 118 to a party, Patrick, who is also supported by the PSTN 118, where Patrick is not connected to or supported by the routing system 1116, the state of Bob's telephone will not be detected or known by the presence server 1104, i.e. no first messages relating to the presence state of Bob's telephone line will be transmitted to the presence server 1104. This is because the only teaching in Michael of how to obtain and maintain presence status of a user is based on calling party identification as determined by calls which must traverse the routing system 1116.

The grounds provided on page 3, paragraph 6, of the Office Action regarding the rejection of claim 8 under 35 U.S.C. 102 based on Michael fail to support a prima facie ground of rejection in view of the actual teachings of Michael regarding FIG. 2 as explained above.

In paragraph 1 of the Office Action related to "Response to Arguments", it is stated that, "The monitoring illustrated in figure 2 along with the fact disclosed in paragraph 34 that the presence system can be implemented on a PSTN supports the fact that the call event information defines when the line is both available and unavailable to receive the call." With regard to paragraph 34, it is stated "either or both of the multimedia server 104 and the presence server 215 may be [have] services provided on or via a PBX or PSTN 118 rather than provided on the LAN 102 (FIG. 5)." One of ordinary skill in the art would understand that this is merely the suggestion that the services as explained in Michael as being provided by the multimedia server 104 and/or the presence server 215 could likewise be provided as part of a different hardware platform. The suggestion made by the Examiner that this would convey to one of ordinary skill in the art how to substantially change the way that call events are monitored is simply without factual support.

There is no express teaching in Michael that call event monitoring should be implemented in a way other than as actually taught in Michael even if the multimedia server or the presence server were combined into the PSTN.

Further, there is nothing implicit in Michael that would lead one of ordinary skill the art to change the technique by which call events are monitored even if the multimedia server or the presence server were combined into the PSTN.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112. (Emphasis added.)

*In re Robertson* addresses the issue of inherency. It is clear that extrinsic evidence must show that the missing descriptive matter (a different way of obtaining and utilizing call state information) is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Further, the mere fact that a certain thing may result from a given set of circumstances is not sufficient. Therefore, one of ordinary skill in the art would not have found it inherent/implicit in the teachings of Michael to create a totally different way of obtaining and utilizing call state information merely by the suggestion that services as explained by Michael could be provided on other hardware.

It must be remembered that the subject matter of claim 8 stands rejected only under 35 U.S.C. 102 based on Michael. That is, grounds required for support under 35 U.S.C. 102 basically requires that the claimed subject matter be disclosed within the "four corners" of the cited document. It is believed to be clear that Michael does not support within its four corners a teaching of the requirements of claim 8 as explained above. Therefore, the rejection of claim 8 under 35 U.S.C. 102 based on Michael should be withdrawn.

Claim 19 (and 20):

Claim 19, which depends on claim 1, defines the step of receiving the first messages as comprising receiving the first messages by a service control point that is part of an intelligent node disposed as part of the PSTN, and the step of transmitting the second message comprises transmitting the second message by the intelligent node on every occurrence of the one telephone line changing from one presence state to another presence state.

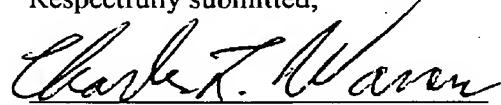
In paragraph 9 of the Office Action it is alleged that Michael discloses a service control point as part of an intelligent node to receive the first message. Applicant respectfully traverses this assertion. The Office Action asserts that the multimedia server may be integrated with the PSTN switch, citing paragraph 29. In such a configuration it is stated that the multimedia server would act as an intelligent node and that the presence module as a service control point of the intelligent node. One of ordinary skill in the art would reject such a suggestion.

Referring to FIG. 5 of Michael, the presence server 215 is contained within the multimedia server 101; see paragraph 30 for the definition of these elements. Because the presence server 215 is contained within the media server 101, to suggest that the presence module 215 would function as a service control point would make the very function of such a service control point redundant as having no purpose. That is, the presence server 215 itself is adapted to maintain and update the presence status; see paragraph 33. Thus, to suggest that the presence server would function as a service control point, whose function is to identify and route messages as needed by other devices, is technically illogical. Therefore, one of ordinary skill in the art would reject the explanation and grounds as advanced in paragraph 9 of the Office Action in considering the requirements of claim 19. The rejection of claim 19 under 35 U.S.C. 102 based on Michael is requested to be withdrawn. For the same reasons stated above, the rejection of claim 20 should also be withdrawn.

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In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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